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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,897	04/12/2001	Kenichi Ueyama	205733US0	1680

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EXAMINER	
GOLLAMUDI, SHARMILA S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,897	UEYAMA ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 11-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 11-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of Request for Continued Examination and Amendments/Remarks received May 10, 2004 is acknowledged. Claims **1-5 and 11-27** are pending in this application. Claims 6-10 stand cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, 13, 15-16, 20-21, and 23 are rejected under 35 U.S.C. 102(a) (e) as being anticipated by Reid et al (5,972,987).

Reid et al disclose a method of removing nits from the hair. The composition contains 50% dimethyl ether, 16.67% isobutene, 30.8% ethanol, 1.5% PVA/VA copolymer, 0.40% isopropyl myristate (oil agent), 0.40% perfume oil, 0.13% silicone (oil agent) and 0.30% eosin Y. The composition is applied to dry hair and allowed to left on the hair for 30 seconds to 5 minutes. The nits are removed and then the hair is shampooed. See column 7 to column 8, lines 12 and example 1. Note that the dyes/colorants utilized in Reid are conventional dyes utilized in the art.

Response to Arguments

Applicant argues that Reid et al is directed to removing lice eggs from infested hair by applying colored dyes to the hair to visualize nits in the hair. Applicant argues that the claim language "consisting essentially of" excludes the dyes since it is inconsistent with the basic and novel characteristics of the instant invention.

Applicant's arguments have been fully considered but they are not persuasive. Firstly, it is pointed out that the claims merely recite "treating the hair", thus Reid et al is clearly treats the hair since the invention is directed to removing lice from the hair by applying a product to hair. Applicant's recitation does not exclude the step of removing lice form the hair. Secondly, it is pointed out that the amended claim language does not exclude Reid's dyes and colorants. Reid teaches the composition comprises various dye routinely utilized in the art for imparting color to the composition itself. These dyes include the conventional pearlescent dyes (iron oxide), FD&C Red #3 , D&C Yellow No. 8, etc.. See column 6. The dye is utilized in the amount of 0.001-0.50%. See column 6. The examiner points to page 4 of the instant specification wherein applicant states that:

> **If desired, the hair treatment composition can contain other components in amounts that do not impair the effects of the present invention.** For example, the composition can contain 0.01 to 50% by weight of surfactants, such as cationic, nonionic, anionic or amphoteric ones, as a solubilizer or an emulsifer; 0.01 to 10% by weight of cationic polymers (e.g., cationic cellulose derivatives), anionic polymers (e.g., polyacrylic acid), or nonionic polymers as a viscosity improver', and 0.01 to 20% by weight of polyhydric alcohols (e.g., glycerol) as a humectant. **Additionally, various extracts, colorants, antiseptics, and antioxidants can be added to the composition in an amount of 0.01 to 5% by weight each.**

Therefore, it is clear that Reid's dyes/colorants do not affect the basic and novel characteristics of the inventive composition as argued by applicant since applicant clearly does exclude dyes

from the inventive composition. Moreover, Reid utilizes the dye in an amount that is substantially less that applicant's upper limit. Thus, the claims are rejected over Reid et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, and 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936).

Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract. The alcohols taught are glycerol, glycols, ethanol, butylene glycol, etc. see column 2, lines 50-57. The oils taught are liquid paraffin, fatty acids, triglycerides, diglycerides, silicon compounds, and fatty alcohols. See column 3, lines 1-15. Komori teaches massaging the hair composition into the scalp hair. The oils liberate or dissolve the dirt on the scalp/hair. This is followed by rinsing the hair with a lot of water to wash the composition out. The composition also provides for a good

for a good feeling upon use. See column 5, lines 14-30. The composition is in the form of a shampoo, preshampoo, a dandruff remover, etc. Further, the preshampoo conditions the hair so as the enable one to shampoo long and wavy hair without tangling. Examples of a preshampoo and a dandruff remover, which acts in the same manner, are disclosed. Note that preshampoos are conventionally applied to dry hair.

Komori does not specify how long the composition is kept in the hair.

It is deemed obvious to one of ordinary skill at the time the invention was made to look to the guidance of Komori et al and manipulate parameters such as concentration of individual components and the length of time the composition is left in the hair. First, one would be motivated to manipulate the concentration since Komori teaches the general parameters of the composition as taught in the abstract which falls within instant range. Therefore, it is prima facie obvious to manipulate variable such as concentration during routine experimentation to optimize the conditions of the prior art.

Additionally, it is deemed obvious to manipulate the amount of time the composition is left in the hair since this is also a variable factor that depends factors such as the length of time it takes to rub the composition into the hair and liberate the dirt, the length of time the consumer is willing to leave the composition on the hair, etc.

Lastly, it is deemed obvious to one of ordinary skill in the art to substitute one oily component with another oil component or one solvent for another. One would be motivated to do so since these oil agents/solvents are conventionally utilized in the hair care industry and Bergmann provides guidance on suitable oil agents and clearly teaches combining different types of oily agents. Absent the criticality of a particular combination, the substitution of one

component known and utilized in the art for a particular purpose with another component known in the art for the same purpose, is prima facie obvious.

Okumura et al teach a preshampoo, hair treating composition. Okumura states that preshampoos comprising oils and fats have gained favor since it prevents damage to the hair during hair washing and finishing, thus imparting a conditioning effect to the washed hair to give the hair an improved look. The treating agent is applied to the hair and washed according to conventional practices. See column 1, lines 30-45. More specifically, Okumura teaches that a hair was coated with 2g of a preshampoo and letting it stand for five minutes, followed by washing. See column 4. Lastly, claim 4, Okumura makes the implicit teaching of applying a preshampoo to dry hair, explicit by stating in claim 4 that the composition is applied to dry hair.

It would have been obvious at the time the invention was made to combine the teachings of Komori et al and Okumura et al and leave the preshampoo in for the instant length of time. One would be motivated to do so since Okumura et al provides the general state of the art at the time the invention was made wherein the reference reveals that is it known to leave preshampoo in the hair for the instant length of time. Further, one would be motivated to increase or decrease this time since Matsunaga teaches preshampoos minimize and prevent damage to the hair and conditioning to the hair. Thus, the length of time would depend on factors such as the severity of damage to the hair, the amount of conditioning desired, and the consumer's willingness and desire to keep the composition in the hair. Moreover, Okumura states the conventional practice of utilizing preshampoo, known tin the art to be applied to dry hair prior to washing the hair. Thus, the reference also provides the state of the art at the time the invention was made wherein it known that preshampoos are applied to dry hair.

Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936), in further view of Priest et al (4,296,763).

Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract. Okumura et al teach the use of a preshampoo conditioner for at least 5 minutes.

The references do not specify warming the hair with a warming cap.

Priest et al disclose a hair conditioning composition contained in a heating cap. The composition contains oil and other components. See column 2, lines 3-14. Priest teaches the use of temperatures in the excess of 125 degrees Fahrenheit allow the oils such as olive oil or synthetic oils to penetrate the hair. See column 2, lines 15-17. Thus, when the hair is washed, the residual oil promotes luster, improves hair condition, and allays irritation. See column 3, lines 23-32.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the reference and use the instant temperature to treat the hair. One would be motivated to do so since Priest et al teach that a temperature in the excess of 125 degrees Fahrenheit allow oils to penetrate the hair shaft. Thus, since Komori teaches a composition for conditioning the hair prior to shampooing containing the same oils as taught by Priest et al, one of ordinary skill would reasonably expect similar results. Therefore, the motivation to utilize Komori's composition with heat is to provide for deeper conditioning benefits.

Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori et al (5,342,611) by itself or in view of Okumura et al (4,402,936), in further view of Hulett et al (4,459,471), optionally in further view of Newell (4,374,125).

Komori et al teach a hair cleansing composition that generally contains 0.05-15% a surfactant, 0.5-40% of an alcohol, 0.1-25% water, and 20-98% of a liquid oil. See abstract. Okumura et al teach the use of a preshampoo conditioner for at least 5 minutes.

The references do not specify warming the hair with a warming cap.

Hulett et al teach an electrical heating cap for applying heat to the hair. The electrical thermostat maintains the desired temperature during the desired conditioning period. See abstract. The frequent use of hot rollers and electrical hair dryers tend to damage the hair, and require hair-conditioning products. These conditioners are applied to the damaged in a heat-controlled environment for a short period of time, usually about 30 minutes. See column 1, lines 5-15. The cap is held at 125 degrees Fahrenheit for a 30-minute conditioning period. See column 5, line 54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the references and utilize a heating cap in combination with the hair conditioner. One would be motivate to do so since Hulett et al teach the state of the art for conditioning damaged hair. Hulett states that applying a conditioner to the hair and heating it with a cap for thirty minutes is known in the art for damaged hair. Therefore, one would be motivated to add heat to provide for a more intensive conditioning process if the hair is severely damaged.

Art of Interest

US patent 4,279,269 to Horin et al is cited to provide a general state of the art wherein a pre-shampoo treatment hair application provides for a composition that is applied to dry hair followed by shampooing.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG

MICHAEL G. HARTLEY
PRIMARY EXAMINER